

REMARKS/ARGUMENTS

Claims 17-32 are pending in the application.

Claims 17, 22 and 32 are presently amended. Claims 17-32 were rejected by the Examiner. The rejections are respectfully traversed.

The Examiner rejected Claims 17-32 under 35 U.S.C. §112, second paragraph, as indefinite for improper antecedent basis. The Applicant has amended Claim 17 to correct the typographical error of "driving" to read "drive", as intended.

The Examiner rejected Claims 17, 18, 22, 24-26, 28-30, and 32 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,896,973 to Hochmuth et al. The Examiner indicated that Reichert discloses "a spindle 10, a driven member 4, a freewheel having locking members 25, a ring 1, a drive member 5 having unlocking members 19, and torque transmitting catch surfaces formed by cam surfaces engaging drive surfaces of catch openings of the driven member . . . [t]he catch openings are radial recesses 22 . . . [t]he cam and locking members are arranged in pairs . . . [t]he driven member is force-lockingly connected to the spindle 10." The Applicant respectfully traverses the rejection.

Applicant respectfully asserts that the rejection under 35 U.S.C. §102(b) is improper since the effective priority date of the Hochmuth et al. application was May 15, 1997 and the effective priority date of the present application was August 26, 1997, which is not "more than one year prior to the date of the application for patent in the United States" as required under §102(b). The Applicant respectfully requests the rejection be withdrawn. As a preliminary matter and in an effort to expedite examination, the Applicant respectfully suggests that an obvious alternative rejection, a §102(e) rejection, would not be appropriate either as the PCT publication

of July 4, 1996 for the Hochmuth et al. application was published only in the German language, and not in English as required by §102(e).

Further, the Examiner has set forth in his rejection only a statement that the cited art ('973) includes certain elements set forth in the rejected claims which do not comprise the claims in their entirety. The Examiner has by no means addressed every element contained in the claims (for example, that the driven member is "fixedly connected to said spindle" and multiple other elements set forth within Claim 17, and, therefore, contained within the remaining dependent claims) and as a result has not made a prima facie case for anticipation under §102(b) since the invention of the prior art cannot be the same invention unless every element described within the claims of the present invention are also described within the prior art citation. Hazeltine Research, Inc. v. Brenner, 382 U.S. 252, 338, 86 S.Ct. 335 (1965). See also MPEP § 2173.05(g), which states that a functional limitation must be evaluated and considered, just like any other limitation of the claim... As a result, the Applicant respectfully requests that the Examiner withdraw the rejection.

However, should the Examiner continue his rejection or make another rejection of anticipation under §102 under a different subsection, the following arguments are respectfully submitted. The device disclosed in the '973 patent is a clamp-type locking mechanism used for adjusting a seat position (title, abstract, and throughout). As disclosed in the summary of the invention, the device of '973 is a "thin walled sheet metal part", and that it is possible to "make the walls of the sheet metal very thin". (Col. 1, Summary of the Invention, lines 49-54.) Further, that a "cylindrical pin" is arranged coaxially to the driving element and the driven element to "ensure that the driving member is always correctly positioned coaxially with respect to the driven member and centered in relation to the housing" and that it is possible

to "form a cup" instead of the pin. Clearly, the invention of '973 is not foreseen to serve the purposes of the present invention--a heavy duty part incorporating an operational spindle having fast rotation for rotational work tools such as drills. Neither the desired effect of utilizing "thin" sheet metal, nor the optional "cylindrical pin" disclosed which *cannot* equate to a work tool spindle, would be useful in the present invention. Further, the invention as disclosed in '973 requires use of a spring element (Col. 6, Claim 1; Col. 5, lines 7-24) as an integral part of its invention, thereby teaching away from the present invention. Therefore, the Applicant respectfully requests that the rejection be withdrawn.

The Examiner has also rejected Claims 17, 21-24, and 28-30 under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 5,794,479 to Schwarzbich. The Examiner indicated that Swarzbich includes "a spindle 26, a driven member 30, a freewheel having locking members 32, a ring 28, a drive member having unlocking members 36 and cams 38 that engage catch openings in the driven member . . . [t]he catch opening are ring segments." The Applicant respectfully traverses the rejections.

The Examiner has set forth in his rejection only a statement that the cited art ('479) includes certain elements set forth in the rejected claims which do not comprise the claims in their entirety. The Examiner has by no means addressed every element contained in the claims (for example, that the driven member is "fixedly connected to said spindle" and multiple other elements set forth within Claim 17, and, therefore, contained within the remaining dependent claims) and as a result has not made a prima facie case for anticipation under §102(e) since the invention of the prior art cannot be the same invention unless every element described within the claims of the present invention are also described within the prior art citation. Hazeltine Research, Inc. v. Brenner, 382 U.S. 252, 338, 86 S.Ct. 335 (1965). See

also MPEP § 2173.05(g), which states that a functional limitation must be evaluated and considered, just like any other limitation of the claim... As a result, the Applicant respectfully requests that the Examiner withdraw the rejection.

However, should the Examiner continue his rejection or make another rejection of anticipation under §102 under a different subsection, the following arguments are respectfully submitted. The device disclosed in the '479 patent is an adjustable member for a seat back of a vehicle which transfers external mechanical or manual force to the seat back (Abstract). This is achieved by turning the shaft gradually into each desired direction by pumping a lever. (Col. 4, lines 58-60). Clearly, the invention of '479 is not foreseen to serve the purposes of the present invention--a heavy duty part incorporating an operational spindle having fast rotation for rotational work tools such as drills. The shaft of '479 is instead used to achieve the adjustments of the device, thereby transferring external mechanical force as disclosed in the Abstract. Further, the invention as disclosed in '479 requires use of a spring element (Col. 4, lines 58-60; Col. 6, Claim 1) as an integral part of its invention, thereby teaching away from the present invention. Therefore, the Applicant respectfully requests that the rejection be withdrawn.

The Examiner has rejected Claims 27 and 31 under 35 U.S.C. §103(a) as obvious over Hochmuth et al. in view of U.S. Patent No. 5,460,253 to Ritter et al. The '479 Hochmuth et al. patent was not granted until August 18, 1998. The priority date for the present invention is 26 August 1997. Therefore the Hochmuth et al. patent cannot serve as prior art for a §103(a) rejection. However, should the Examiner continue his rejection, it is respectfully submitted that the Hochmuth reference as discussed above for the §102(b) rejection would be inappropriate for combining as a §103(a) rejection reference; given the disparity in the types of

applications and differences in the invention, there is no suggestion or teaching offered for combining the '973 reference, a different art, with the Ritter reference. "Even if all of the elements of a claim are present in the prior art, the claim will not be obvious unless the prior art also contained, at the time the claim was filed, a motivation to combine prior art elements into the claimed invention." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340,1352 (Fed. Cir. 1998). Therefore, the Applicant respectfully requests that the rejections be withdrawn.

The Examiner has rejected Claims 19 and 20 under 35 U.S.C. §103(a) as obvious over Hochmuth et al. in view of U.S. Patent No. 5,950,783 to Cahill. The Cahill patent was not granted and published until September 14, 1999. The Applicant respectfully traverses the rejection. As such it cannot serve as proper prior art to show anything at the "time of invention" as required under §103(a). Therefore, the Applicant respectfully requests that the rejection be withdrawn.

The Applicant believes that all claims should now be in line for allowance. The Applicant has attempted to be fully responsive to the office action. However, if the Examiner believes that such would be helpful, he is invited to telephone the undersigned to discuss the application.

Respectfully submitted,



Robert W. Becker, Reg. 26,255
Attorney for Applicant(s)

ROBERT W. BECKER & ASSOCIATES
707 Highway 66 East, Suite B
Tijeras, New Mexico 87059

Telephone: 505 286 3511
Telefax: 505 286 3524

RWB:KCF:mac